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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,797	03/15/2005	Hiroynki Tomizawa	743421-81	7499
22204 7590 10/30/2008 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128				
EXAMINER SHEEHAN, JOHN P				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
10/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/527,797

**Applicant(s)**

TOMIZAWA ET AL.

**Examiner**

John P. Sheehan

**Art Unit**

1793

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 22 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/John P. Sheehan/  
Primary Examiner, Art Unit 1793

Continuation of 11, does NOT place the application in condition for allowance because: applicants argue the that the Examiner has failed to establish a prima facie case of obviousness for at least 4 reasons. Applicants argue that the Examiner has not:

I. "demonstrated how Uchida whether taken alone or in combination, discloses or suggests each and every feature of the claims. See M.P.E.P. 2143".

II. "shown any reasonable probability of the existence of success in modifying Uchida...in a manner that could somehow result in the claimed invention. See id"

III. "identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the apparatus of Uchida in a manner that could somehow result in the claimed invention. see id."

IV. "explained how his obviousness rationale could be found in the prior art --- rather than being hindsight reconstruction of Applicants' own disclosure. See id."

In making these arguments applicants have cited MPEP 2143, without citing any specific section of MPEP 2143. MPEP 2143 is approximately 10 to 11 pages long with seven subsections and numerous examples. Without more detailed guidance from applicants it is not clear exactly what part of MPEP 2143 that applicants are relying on in making the above arguments. Thus, applicants' arguments cannot be properly evaluated and therefore are not persuasive. Further, it is the Examiner's position that the statement of the rejection meets the requirements of a properly formulated rejection under 35 USC 103. It is also noted that the claims are not directed to an apparatus and thus it is not understood why the Examiner should present a rationale as to the modification of Uchida's apparatus.

Applicants' arguments based on applicants' Figure 1 regarding the use of "less than 0.96%" B in combination with Ga are not persuasive. Uchida '365's specific examples, cited in the rejection, contain 0.97 wt% boron which closely approximates the instantly claimed upper limit of 0.96 wt% boron one of ordinary skill in the art would have expected the specific examples of R-T-B sintered magnets taught by Uchida '365 to have the same properties. See in re Peterson, 65 USPQ2d 1379, 1382, citing Titanium Metals Corp. v. Banner, 227 USPQ 773, 779 and MPEP 2144.05.

"a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8%nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75%nickel, 0.25% molybdenum, balance titanium and 0.94%nickel, 0.31% molybdenum, balance titanium.).

The data in applicants' Figure 1 indicates that there is little difference in the magnetic properties between a Ga containing alloy containing 0.96% B as recited in the instant claims and a Ga containing alloy containing 0.97% B as exemplified in Uchida '365. Actually, in some cases the Ga containing alloy containing 0.97% B as taught by Uchida '365 has better properties than the applicants' Ga containing alloy containing 0.96% B, for example, see the intrinsic coercivity for the as sintered embodiment and the heat treated at 773 K embodiment.

Applicants' argument with respect to claim 5 that Figure 1 demonstrates that the heat treatment recited in claim 5 drastically increases the intrinsic coercivity is not persuasive. First, it is pointed out that the claims are directed to a sintered product and not a heat treated product. Second, Figure 1 indicates that the heat treated Ga containing alloy containing 0.97% B as taught by Uchida '365 has better intrinsic coercivity than the applicants' heat treated Ga containing alloy containing 0.96% B, for example, see the intrinsic coercivity for the as sintered embodiment and the heat treated at 773 K embodiment.